

## Remarks

Applicants have read and considered the Office Action dated October 7, 2008 and the references cited therein. Claim 1, 7, 14 and 18-22 have been amended. Claims 4, 10 and 17 have been cancelled without prejudice or disclaimer. Claims 1-3, 5, 7-9 and 11-16, and 18-24 are currently pending.

Reconsideration of the present application is respectfully requested in view of the following remarks. Prior to entry of this response, Claims 1-5 and 8-24 were pending in the application and Claim 23 was allowed, of which Claims 1 and 23 are independent. In the Office Action dated October 7, 2008, Claim 10 was objected to due an informality, Claims 1-5, 7-22, and 24 were rejected under 35 U.S.C. § 112 ¶ 1, Claims 7, 14, and 22, while rejected under 35 U.S.C. § 112 ¶ 1, contain allowable subject matter, Claims 1-5, 8-9, 11-13, 15-21, and 24 were rejected under 35 U.S.C. § 103. Claim 23 has been allowed. Following this response, Claims 1-3, 5, 7-9, and 11-16 and 18-24 remain in this application, with Claims 4, 10 and 17 being cancelled without prejudice or disclaimer. Applicants hereby address the rejections in turn.

### I. Objection to the Claim

In the Office Action dated October 7, 2008, Claim 10 was objected to as containing informalities. Claim 10 has been cancelled to address these informalities and do not narrow the claimed subject matter. Applicants respectfully submit that the amendment overcomes this objection and adds no new matter.

### II. Rejection of the Claims Under 35 U.S.C. §112, First Paragraph

In the Office Action, Claims 1-3, 5, 8-9, 11-22, and 24 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in

such a way to reasonably convey to one skilled in the art, at the time the application was filed, that the inventor had possession of the claimed invention. Claim 1 has been amended to clarify the invention and does not narrow the claimed subject matter. Applicants respectfully submit that the amendment overcomes this rejection and adds no new matter.

### III. Rejection of the Claims under 35 U.S.C. § 102(b) 35 U.S.C. § 103(a)

In the Office Action, Claims 1-3, 5, 8-9, 15, 17, and 24 were rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,485,794 ("*Li*"). Claim 11 was rejected under 35 U.S.C. § 103(a) as being obvious over *Li* in view of U.S. Patent No. 6,508,922 ("*Kimpel*") and U.S. Patent No. 5,378,275 ("*Shiraga*"). Claims 12-13, 16, 19, and 21 were rejected under 35 U.S.C. § 103(a) as being obvious over *Li*. Claim 18 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of EP 1 129 785 ("*Owed*"). Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Li* in view of *Owed* and U.S. Patent No. 3,846,223 ("*Lederman*"). Claim 1 has been amended to include the limitation of claim 4, and Applicants respectfully submit that the amendment overcomes this rejection and adds no new matter.

Amended Claim 1 is patentably distinguishable over the cited art for at least the reason that it recites, for example, "at least one multifunctional acrylic monomeric reactive diluent." Support for these amendments can be found in the specification at least on page 2, paragraphs [0039].

In contrast, *Li* at least does not disclose the aforementioned recitation. For example, *Li* merely discloses that a coating composition includes at least one film-forming ingredient that can be cured using thermal cure at less than 200°C or radiation-induced cure. The film formers in *Li* include urethanes, acrylics, epoxies, melamines and blends or copolymers thereof. (See col. 3, lines 44-46.) *Li* further discloses that a cured coating forms a lubricant layer on a surface of a

container or a conveyor. (See col. 1, lines 58-59.) The lubricant composition in *Li* further discloses that the lubricant composition does not require in-line dilution with significant amounts of water. (See col. 2, lines 46-48.) The lubricant composition may be applied undiluted or with relatively modest dilution, for example at a water to lubricant ratio of about 1:1 to 5:1. (See col. 3, lines 48-50.) Consequently *Li* discloses a coating that includes at least one film former that does not require dilution for allowing a bottle to better glide over the conveyers. *Li* however does not disclose or suggest that the coating includes one or more resins comprising a urethane-acrylate oligomer, in a weight percentage of between 30wt% and 60wt% and at least one multifunctional acrylic monomeric reactive diluent. Accordingly, *Li* does not disclose at least one multifunctional acrylic monomeric reactive diluent as disclosed in the aforementioned recitation.

Accordingly, *Li* does not anticipate or render obvious the claimed invention because *Li* at least does not disclose "at least one multifunctional acrylic monomeric reactive diluent," as recited by amended Claim 1. Accordingly, independent Claim 1 patentably distinguishes the present invention over the cited art or any combination thereof, and Applicants respectfully request withdrawal of this rejection of Claim 1.

Dependent Claims 2-3, 5, 8-16, 18-21, and 24 are also allowable at least for the reasons described above regarding independent Claim 1, and by virtue of their dependency upon independent Claim 1. Accordingly, Applicant respectfully requests withdrawal of this rejection.

Moreover, Applicants respectfully request withdrawal of the rejections to dependent Claims 2-3, 5, 8-16, 18-21, and 24 at least for the reasons described above regarding independent Claim 1, and by virtue of their dependency upon independent Claim 1.

IV. Allowable Claims

Applicants note that Claim 23 has been allowed. Applicants thank the Examiner for the allowance of Claim 23. Moreover, claims 7, 14 and 22 were indicated as having allowable subject matter. Applicants thank the Examiner for the indication of allowable subject matter in these claims. Claims 7 and 14 have been rewritten in independent form and to overcome the rejections under 35 U.S.C. §112. Claim 22 has been rewritten in independent form and to incorporate claim 1 and intervening claim 17 and to overcome the rejections under 35 U.S.C. §112. Applicants assert that the claims and the claims depending therefrom are in condition for allowance.

A speedy and favorable action in the form of a Notice of Allowance is hereby solicited. If the Examiner feels that a telephone interview may be helpful in this matter, please contact Applicant's representative at (612) 336-4728.

Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers or any future reply, if appropriate. Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725.



Respectfully submitted,

MERCHANT & GOULD P.C.

Dated: \_\_\_\_\_

2/9/09

By: \_\_\_\_\_

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